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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 878.0003.U1(US) | | | |
|---|---|---|---------------------|---|--|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR on _____ Signature _____ Typed or printed name <u>Ann Okrentowich</u> | Application Number 10/088,061 | | Filed 08/12/2002 | | |
| | First Named Inventor Casais, Eduardo | | | | |
| | Art Unit 2617 | Examiner Karikari, K. | | | |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | | | |
| I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>31,686</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | | | |  Signature <u>Mark F. Harrington</u> Typed or printed name <u>(203) 925-9400</u> Telephone number <u>12/11/07</u> Date | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*. | | | | | |

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|---|
| <input type="checkbox"/> *Total of _____ forms are submitted. |
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/088,061
Applicant(s): Casais
Filed: 08/12/2002
Art Unit: 2617
Examiner: Karikari, Kwasi
Title: Supply of Electronic Data

Confirmation No.: 8518

Attorney Docket No.: 878.0003.U1(US)
Customer No.: 29,683

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Arguments Accompanying Pre-Appeal Brief Request For Review

Sir:

Claims 1, 2, 6-8, 11-12, 14-16, 20-23 and 25-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Birgeron (US 6,138,009) in view of Levy et al. (US 6,505,160 B1).

The present application has priority back to September 16, 1999. The examiner has indicated that the USPTO has received the certified copy of the priority document. The priority application was in English.

Levy et al. was filed on May 2, 2000. Thus, Levy et al. was filed **after** the priority date of the present application. Levy et al. claims priority on U.S. provisional application No. 60/134,782.

The examiner bases his rejection upon the disclosure in Levy et al. (US 6,505,160 B1) that "The path of the identifier from the decoding process, and the return path from a server to the communication application may include one or more hops through a wire or wireless connection using standard wire and wireless communication protocols like TCP/IP, HTTP, XML, WAP, **Bluetooth**, etc." (Column 5, lines 61-66). However, the provisional patent application has no such disclosure. This disclosure only first appears in the utility

application filed on May 2, 2000. This was **after** applicant's priority date of September 16, 1999. Thus, this disclosure in Levy et al. (US 6,505,160 B1) is not prior art. (See MPEP 2136.02(II) and MPEP 2136.03(III) and MPEP 706.02(f)(1)(I).

The provisional application does mention a "short-range wireless broadcast" (see page 10, lines 5-8). However, Levy et al. (US 6,505,160 B1) does not have this disclosure (and does not incorporate the provisional patent application by reference). Thus, this disclosure of a "short-range wireless broadcast" in the provision patent application is not part of the disclosure of Levy et al. (US 6,505,160 B1). As noted in MPEP 2136.02(II), portions of a patent application which were canceled are not part of the patent or application publication and thus cannot be relied on in a ...[prior art] rejection. In this case, subject matter in the provisional patent application 60/134,782 was canceled and not contained in Levy et al. (US 6,505,160 B1). Thus, that canceled (non-included) subject matter is not part of Levy et al. (US 6,505,160 B1) and cannot be used by the examiner in rejecting applicant's claims.

As noted above, the provisional application 60/134,782 does mention a "short-range wireless broadcast" (see page 10, lines 5-8). But this is totally unrelated to the disclosure relating to Bluetooth in Levy et al. (US 6,505,160 B1). The "short-range wireless broadcast" (see page 10, lines 5-8) mentioned in the provisional application relates to a personal music library providing music to a user's playback device by a short-range wireless broadcast. The reference to "Bluetooth" in Levy et al. (US 6,505,160 B1), on the other hand, is in regard to a path of an identifier from a decoding device to a server or from a server to a communication application. This is a path **reverse** to a path described at page 10, lines 5-8 of the provisional application from a personal music library providing music to a user's playback device. Levy et al. (US 6,505,160 B1) does not properly support the subject matter disclosed in see page 10, lines 5-8 of the provisional application to fulfill 35 U.S.C. 112, first paragraph. More importantly, in this case the provisional application does not support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. The provisional application does not support the disclosure "The path of the identifier from the decoding process, and the return path from a server to the communication application may include one or more hops through a wire or wireless connection using standard wire and wireless communication protocols like TCP/IP, HTTP, XML, WAP, **Bluetooth**, etc."

(Column 5, lines 61-66 in Levy et al. (US 6,505,160 B1)). Thus, because the provisional application 60/134,782 does not properly support the subject matter relied upon to make the rejection (in compliance with 35 U.S.C. 112, first paragraph), Levy et al. (US 6,505,160 B1) is not entitled to the benefit of the filing date of the provisional application in regard to that disclosure. (See MPEP 2136.03(III)). The examiner's rational for the rejection is flawed and should be reversed.

In the advisory action mailed 11/19/2007, the examiner mentions "well known in the art" for the first time. The examiner has not officially based his rejection upon "well known in the art" or "official notice" grounds. The official rejection is merely under 35 U.S.C. §103(a) as being unpatentable over Birgeron (US 6,138,009) in view of Levy et al. (US 6,505,160 B1). If the examiner was changing his rejection, then Applicants' attorney also hereby challenges the examiner's "Official Notice". In accordance with MPEP §2144.03 the USPTO is requested to cite a reference in support of this "well known in the art" position.

Considering that Column 5, lines 61-66 of Levy et al. (US 6,505,160 B1) is not entitled to the filing date of the provisional patent application and, therefore, is not prior art, nowhere in the cited art is there a disclosure or suggestion of the features recited in the claims. For example, claim 1 claims:

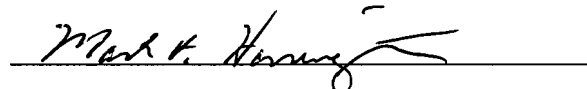
A system for supplying data in electronic form comprising a mobile terminal and a supplying terminal, the supplying terminal comprising a first communication transceiver configured to receive data from at least one data server and second communications transceiver configured to send at least part of the data to the mobile terminal over a wireless connection, wherein the first communication receiver is configured to obtain electronic data from the at least one data server by communication over a wireless network, and wherein the wireless connection is a Low Power Radio Frequency (LPRF) connection.

This unique type of system is not disclosed or suggested in the references which are prior art (**before September 16, 1999**). Therefore, the rejection of the claims as it currently stands should be withdrawn.

Appl. No.: 10/088,061

For all of the foregoing reasons, it is respectfully submitted that all of the claims present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested.

Respectfully submitted,



Mark F. Harrington (Reg. No. 31,686) Date



12/11/07

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